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**THIS DISPOSITION
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Paper No. 11
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Computer Corporation of America

Serial No. 75/481,164

Maggie A. Lange and Jerry Cohen of Perkins, Smith & Cohen
for applicant.

Scott Baldwin, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before Simms, Quinn and Chapman, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Computer Corporation
of America to register the mark shown below

for "computer software, namely, database access software
which performs in a client server architecture, and is
installable on personal computers, or other intelligent
client terminals, and in a local network as a gateway to

data stored on a mainframe."¹ The word "Connect" is disclaimed apart from the mark.

Registration has been refused by the Trademark Examining Attorney under Section 2(d) of the Act on the ground that applicant's mark, when used in connection with applicant's goods, so resembles the previously registered mark CONNECT for "computer programs and instruction manuals sold therewith for use with personal computers in accessing informational databases"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

The Examining Attorney contends that the marks are similar in that the literal portions of the marks are identical. According to the Examining Attorney, the addition of the star design in applicant's mark is insufficient to distinguish it from registrant's mark. The Examining Attorney also maintains that the goods, as identified, are virtually identical or otherwise

¹ Application Serial No. 75/481,164, filed May 7, 1998, alleging first use anywhere and first use in commerce on December 31, 1993.

² Registration No. 1,372,228, issued November 26, 1985; combined Sections 8 and 15 affidavit filed.

substantially related. The Examining Attorney submitted a dictionary definition of the term "connect."

Applicant argues that the marks as a whole are distinguishable. Applicant also contends that the goods are sufficiently different, asserting that "the non-specific registration of the prior mark should not prejudice later applicants for registration which identify goods/services with adequate precision" and that "it is contrary to public policy to require an applicant, in circumstances of the type presented here, to force an applicant to seek partial cancellation of an overbroad prior registration." (brief, p. 2). Applicant further states that purchasers of the goods are sophisticated and that there has been no actual confusion between the marks.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks have obvious similarities in sound and appearance. Applicant has adopted the entirety of registrant's mark and merely added a subordinate star design to it. See: Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975)[the mere addition of subordinate matter to a registered mark generally is not sufficient to avoid a likelihood of confusion]; and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987)[when a mark consists of a word and design, the word portion is more likely to be remembered by purchasers and to be used in calling for the goods]. As to connotation, although the term "connect" may have a meaning relative to the goods involved herein, both marks convey the same thought, that is, that the computer programs function to join or connect a computer with a database.

In sum, the marks, when considered in their entireties, engender substantially similar overall commercial impressions such that, if used in connection with related goods, confusion would be likely to occur.

Insofar as the goods are concerned, it is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances

surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). Further, the identifications of goods in the application and the cited registration control the comparison of the goods. See: Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)("[T]he question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be."); and In re Elbaum, 211 USPQ 639 (TTAB 1981).

When the goods are compared in light of the legal constraints cited above, we find that applicant's "computer software, namely, database access software which performs in a client server architecture, and is installable on personal computers, or other intelligent client terminals, and in a local area network as a gateway to data stored on a mainframe" is related to registrant's broadly identified

"computer programs and instruction manuals sold therewith for use with personal computers in accessing informational databases." For purposes of the legal analysis of likelihood of confusion herein, it is presumed that registrant's registration encompasses all goods of the nature and type identified, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers. In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992); and In re Elbaum, supra at 640. Although their products, in reality, may be specifically different, both applicant's and registrant's computer software, as identified, is used to allow personal computers to access databases. There are no limitations in registrant's identification of goods and, thus, we must presume that registrant's software may be used in client server architecture and in a local area network. Further, we must presume that registrant's computer programs are purchased not only by individuals, but also by computer professionals to access databases in computer networks. Thus, the goods, as identified, are presumed to travel in the same or similar channels of trade and are bought by the same classes of purchasers.

We recognize applicant's contention that the average purchaser buying its product is "a sophisticated organization with a background in networked systems, massive data bases, retrieval and storage strategies, information systems, management and finance through one or more of the organization's personnel and departments." (response, June 22, 1999). Applicant's statement, however, is not supported by any evidence in the record. In any event, although this factor would favor applicant, it is outweighed by the similarities between the marks and the goods.

In finding likelihood of confusion, we acknowledge applicant's concern about the scope of protection being given to the cited registration (brief, p. 2), but applicant is not without remedies in its attempt to obtain a registration. Applicant may seek a consent from the owner of the cited registration, or applicant may seek a restriction in the cited registration, pursuant to Section 18 of the Act, that may serve to avoid a likelihood of confusion. See: Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266 (TTAB 1994). Compare: Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992)[no likelihood of confusion between

specifically identified computer services and programs in different fields].

Applicant points to the absence of any actual confusion between the involved marks in the time since applicant began using its mark. As a du Pont factor, the absence of actual confusion weighs in applicant's favor. The probative weight is very limited here, however, by the fact that there are no specifics regarding the extent of use by applicant or registrant. Thus, there is no way to assess whether there has been a meaningful opportunity for confusion to occur in the marketplace.

We find that purchasers familiar with registrant's computer programs for use with personal computers in accessing informational databases sold under the mark CONNECT would be likely to believe, upon encountering applicant's mark CONNECT and star design for computer software, namely, database access software which performs in a client server architecture, and is installable on personal computers, or other intelligent client terminals, and in a local area network as a gateway to data stored on a mainframe, that the goods originated with or were somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points argued by applicant casts doubt on our ultimate conclusion on the

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issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.